IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Parmeshwar GOBIN *et al.*	Confirmation No.: 3054
Application No.: 10/822,509	Group Art Unit: 3687
Filed: April 12, 2004	Examiner: Ade, Oger Garcia
Attorney Docket No.: COS97104C1	

For: WEB BASED INTEGRATED CUSTOMER INTERFACE FOR INVOICE
         REPORTING

Commissioner for Patents
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed August 11,

2010.

I.   STATUS OF THE CLAIMS

Claims 21-39 are pending in this appeal, in which claims 1-20 were previously canceled

and claim 40 stands withdrawn from consideration pursuant to the provisions of 35 U.S.C. § 121.

No claim is allowed. This appeal is therefore taken from the final rejection of claims 21-39 on

December 9, 2009.

II.   GROUNDS OF REJECTION TO BE REVIEWED

Claims 26-30 and 36-39[1] were rejected as being directed to non-statutory subject matter under 35 U.S.C. §101.

Claims 21-39 were rejected for anticipation under 35 U.S.C §102(e) based on *Barry et al.* (US 6,615,258).

III.   ARGUMENT

Initially, Appellants maintain and incorporate herein the arguments advanced in the Appeal Brief filed May 28, 2010. The arguments presented *infra* address certain new assertions presented by the Examiner in the Answer.

The Examiner has maintained the rejection of claims 26-30 under 35 U.S.C. §101, relying on the machine-or-transformation test of *In re Bilski*, 544 F.3d 943, 88USPQ2d 1385 (Fed. Cir. 2008) (en banc). For the reasons previously argued in the Principal Brief, claims 26-30 do pass muster under that machine-or-transformation test because computers are statutory within the meaning of 35 U.S.C. §101, in that they are, indeed, **machines**. The claims meet the transformation test because there is a transformation of a request for invoice data into a physical display of an actual invoice document, which did not exist before the claimed method provided the document. The claims meet the "machine" test because the methods are carried out using a "processor" and a "database," both physical elements, or "machines," within the meaning of 35 U.S.C. §101.

In any event, while the Supreme Court affirmed the judgment of the Federal Circuit in concluding that the claimed subject matter therein was non-statutory, *Bilski et al. v. Kappos*, 561

---

[1] Based on the statement of rejection and reasons therefore at pages 3-5 of the Answer, it appears that the Examiner now only rejects claims 26-30 under 35 U.S.C. §101.

U.S. ___ (2010), the Court made it clear that the term "process," within 35 U.S.C. §101, is **not required** to be tied to a machine or to transform an article, i.e., the Federal Circuit's machine-transformation test may not be the "sole test" for what constitutes a "process" within the meaning of 35 U.S.C. §101.

Although claims 26-30 are patent-eligible under the machine-or-transformation test, they are also patent-eligible as belonging to at least one statutory category of invention within 35 U.S.C. §101, e.g., "process" or "machine," and do not fall into one of the judicially-exempt categories of merely being a mathematical algorithm, an abstract idea, or a law of nature.

A method for providing an on-line invoice by employing physical machines, comprising a processor and a database, for performing the claimed sequence of manipulative steps set forth in claim 26 is clearly a "process" within the meaning of 35 U.S.C. §101 and is patent-eligible within the context of *Bilski et al. v. Kappos*.

Accordingly, the Honorable Board's reversal of the Examiner's rejection of claims 26-30 under 35 U.S.C. §101 is respectfully solicited.

With regard to the rejection of claims 21-39 under 35 U.S.C. §102(e) based on *Barry et al.*, responsive to Appellants' argument that *Barry et al.* fails to disclose all of the claim features, the Examiner sets forth a litany of alleged disclosures by *Barry et al.* at pages 10-11 of the Answer, essentially repeating the arguments at pages 10-11 of the Final Office Action, without responding specifically to Appellants' arguments.

Appellants asserted, and continue to assert, that there is no disclosure in *Barry et al.* of "**compressing** the invoice data for storage in a database" or "**creating key information** for retrieving the compressed invoice data." Appellants maintain that *Barry et al.* lacks any teaching

of these specific claim features and the Examiner has failed to establish a *prima facie* case of anticipation for at least this reason.

At pages 5-6 of the Answer, the Examiner points to "at least column 46; lines 8-15" of *Barry et al.* for a supposed teaching of "**compressing** the invoice data for storage in a database." However, this cited portion of the reference relates to information stored in database 1355 generally originating from different billing systems and that when data is available from these billing systems, an online server may perform a conversion process and store converted data on tape until an audit approval. After auditing and approval, the converted data having the invoicing documents are stored to the database 1355. While data relating to an invoice may be "converted," there is no indication that such data is "compressed."

But, even assuming, *arguendo*, that invoice data is compressed for storage in a database in *Barry et al.*, *Barry et al.* is still devoid of any teaching of "**creating key information** for retrieving the compressed invoice data." The Examiner relied on steps 630 and 632 (Fig. 13a?) of *Barry et al.* to provide for this claim feature (Answer-page 6). In particular, the Examiner asserted, "the **DSS IAIO** reads the header to determine which Data Mart will ultimately be queried. It then parses the metadata into a format which the COTS software can readily **convert into a SQL query, as indicated at step 635, FIG. 13(b)**." Reading a header to determine what to query, and then parsing metadata into a format that can be converted into a SQL query is hardly a disclosure, or even a suggestion of "**creating key information** for retrieving the compressed invoice data." In the cited portion of *Barry et al.*, no "key information" is created. (The Examiner does not even identify what is the "key information" supposedly taught by *Barry et al.*). Moreover, there is no indication that whatever "key information" is allegedly taught by

Barry et al. is created to retrieve anything, let alone retrieve the "compressed invoice data" previously recited in the claim.

Thus, again, the Examiner has failed to establish *prima facie* case of anticipation regarding the subject matter of claims 21-39.

At pages 11-12 of the Answer, the Examiner purportedly responds to Appellants' argument that *Barry et al.* fails to disclose any calculations performed on figures selected from the invoice document. However, the Examiner merely reiterates the position that the Report Manager 250 of *Barry et al.* "includes and provides access to the metadata which is used to tell the Report Requestor what a standard report should look like and the 'pick-list' options the user has in order for them to customize the standard report. It is used to tell the Report Viewer client how to display the report, what **calculations or translations** need to be performed at the time of display…" (Answer-page 11, emphasis in the original).

However, while Report Manager 250 may provide access to metadata, it clearly does not provide for "selecting figures presented in the invoice document for performing an arithmetic operation on the selected figures," as claimed. Moreover, to the extent that the Report Viewer may indicate to the client "what **calculations or translations** need to be performed," indication to a viewer of what needs to be done is much different from actually doing it. The claimed invention provides for **actually performing** the calculation, e.g. claim 24: "the host supports selecting figures presented in the invoice document **for performing an arithmetic operation on the selected figures."** *Barry et al.* provides for no such feature.

In any event, the mere disclosure of some generic "calculation" by an online invoice server in *Barry et al.* does not amount to a disclosure of "wherein the host supports selecting figures presented in the invoice document for performing an arithmetic operation on the selected

figures." *Barry et al.,* in no way, suggests that any calculation is **performed on figures selected from the invoice document**, as claimed.

Accordingly, reversal, by the Honorable Board, of the Examiner's rejection of claims 1-39 under 35 U.S.C. §102(e) is respectfully solicited.

IV.   CONCLUSION AND PRAYER FOR RELIEF

Appellants, therefore, request the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

September 28, 2010   /Phouphanomketh Ditthavong/
Date   Phouphanomketh Ditthavong
                                                    Attorney for Applicant(s)
                                                    Reg. No. 44658

                                                    Errol A. Krass
                                                    Attorney for Applicant(s)
                                                    Reg. No. 60090

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9952
Fax (703) 519-9958